

### **REMARKS**

This Amendment is responsive to the Office Action identified above, and is further responsive in any other manner indicated below.

### **PENDING CLAIMS**

Claims 1-29 were pending, under consideration and subject to examination in the Office Action. Appropriate claims have been amended, canceled and/or added (without prejudice or disclaimer) in order to adjust a clarity and/or focus of Applicant's claimed invention. That is, such changes are unrelated to any prior art or scope adjustment and are simply refocused claims in which Applicant is presently interested. At entry of this paper, Claims 1-23, 26, 27 and 29 remain pending for consideration and examination in the application.

### **ALLOWED CLAIMS**

Claims 13-23 and 27 are allowed in the application, as indicated within the section number "4" on page 9 of the Office Action. Claims 13, 15, 17 and 27 have been minorly amended within this paper in a manner believed not to affect an allowability thereof. Renewal of such indication of allowance is respectfully requested. Applicant and the undersigned respectfully thank the Examiner for such indication of allowed subject matter.

### **NON-REWRITTEN ALLOWABLE CLAIM**

Although Claim 3 has been indicated as being allowable if rewritten, as indicated within the section number "5" on page 9 of the Office Action, rewriting has

not yet been effected as it is believed that any base and intervening claims will be allowed responsive to this paper. Applicant respectfully reserves the right to rewrite the potentially allowable claims at a later time if necessary, and Applicant and the undersigned respectfully thank the Examiner for such indication of potentially allowable subject matter.

### **REJECTION UNDER 35 USC §102 - TRAVERSED**

The 35 USC §102 rejection of Claims 1, 2, 4-12, 24-26, 28 and 29 as being anticipated by Ishimaru et al. (US 2001-0030296-A) is respectfully traversed. Such rejections have been rendered obsolete by the present clarifying amendments to Applicant's claims, and accordingly, traversal arguments are not appropriate at this time. However, Applicant respectfully submits the following to preclude renewal of any such rejections against Applicant's clarified claims.

Unrelated to any prior art rejection, Claims 24, 25 and 28 are now canceled (without prejudice or disclaimer), thus rendering this rejection of such claims obsolete at this time. Patentability of remaining ones of the rejected claims are supported as follows.

All descriptions of Applicant's disclosed and claimed invention, and all descriptions and rebuttal arguments regarding the applied prior art, as previously submitted by Applicant in any form, are repeated and incorporated herein by reference. Further, all Office Action statements regarding the prior art rejections are respectfully traversed. As additional arguments, Applicant respectfully submits the following.

At the outset, as to the requirements to support a rejection under 35 USC §102, reference is made to the decision of *In re Robertson*, 49 USPQ2d 1949 (Fed. Cir. 1999), wherein the court pointed out that anticipation under 35 USC §102 required that each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. As noted by the Court, if the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if the element is “inherent” in its disclosure. To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” Moreover, the Court pointed out that inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

Thus, in order to properly support a §102 anticipatory-type rejection, any applied art reference must disclose each and every limitation of any rejected claim. However, the cited art does not adequately support either a §102 anticipation-type rejection or a §103 obviousness-type rejection because it does not, at minimum, disclose (or suggest) the following limitations of Applicant’s clarified claims as discussed by Applicant’s foreign representative in support of traversal of the rejection and patentability of Applicant’s claims.

The Examiner alleges that the invention as claimed in prior Claims 1, 2 and 4-12 is disclosed by Ishibashi *et al.*

However, at minimum, it is believed that at least the features/limitations of classifying into concave defects and convex defects, and further classifying concave

defects into scratch defect and thin film-like foreign materials, such as claimed in

Claim 5, are not taught by Ishibashi *et al.*

At page 4 of the Office Action, the Examiner alleges that the characteristic content relevant to Claim 5 of the present invention is indicated by Fig. 2 of Ishibashi *et al.* However, Fig. 2 of Ishibashi *et al.* does not show classifying concave defects into thin film-like foreign materials (defects), which is one of the features/limitations of Claim 5 of the present application.

The Examiner has further alleged that discriminating a flat thin film-like foreign material (defect), such as claimed in Claim 25 of the present application, is indicated by the paragraph [0095] of Ishimaru *et al.* Also, the Office Action alleges that discriminating a flat thin film-like foreign material (defect) in Claim 29 of the present application is indicated by the paragraph [0062] and Fig. 21 in Ishimaru *et al.* However, it is believed that it is not indicated in neither of the pointed-out parts of Ishibashi *et al.* about discriminating a flat thin film-like foreign materials (defects), such as claimed in Claims 25 and 29 of the present application, *i.e.*, classifying concave defects into scratches (defects) thin film-like foreign materials (defects).

As a result of all of the foregoing, it is respectfully submitted that the applied art would not support a §102 anticipatory-type rejection or §103 obviousness-type rejection of Applicant's claims. Accordingly, reconsideration and withdrawal of such §§102 and 103 rejections, and express written allowance of all of the rejected claims, are respectfully requested.

### **RESERVATION OF RIGHTS**

It is respectfully submitted that any and all claim amendments and/or cancellations submitted within this paper and throughout prosecution of the present application are without prejudice or disclaimer of any scope or subject matter. Further, Applicant respectfully reserves all rights to file subsequent related application(s) (including reissue applications) directed to any/all previously claimed limitations/features which have been subsequently amended or cancelled, or to any/all limitations/features not yet claimed, *i.e.*, Applicant continues (indefinitely) to maintain no intention or desire to dedicate or surrender any limitations/features of subject matter of the present application to the public.

### **EXAMINER INVITED TO TELEPHONE**

The Examiner is invited to telephone the undersigned at the local D.C. area number of 703-312-6600, to discuss an Examiner's Amendment or other suggested action for accelerating prosecution and moving the present application to allowance.

### **CONCLUSION**

In view of the foregoing amendments and remarks, Applicant respectfully submits that all of the claims listed above as presently being under consideration in the application are in condition for allowance. Accordingly, allowance of such claims is respectfully requested.

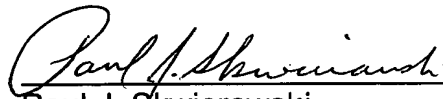
Attached hereto is a Petition for an appropriate extension of time for entry and consideration of this paper. To whatever other extent is actually appropriate, Applicant respectfully petitions the Commissioner for an extension of time under 37

HAMAMATSU *et al.*, SN 10/050,776  
Amdt. filed 08/05/2004  
Reply to OA dated 03/05/2004

520.41064X00/NT0550US  
Page 22

CFR §1.136. Also attached is a Form PTO-2038 which authorizes payment of the requisite fees. Please charge any actual and necessary deficiency in fees to ATS&K Deposit Account No. 01-2135 (as Case 500.41064X00).

Respectfully submitted,



Paul J. Skwierawski  
Registration No. 32,173  
ANTONELLI, TERRY, STOUT & KRAUS, LLP  
1300 North Seventeenth Street, Suite 1800  
Arlington, Virginia 22209-3801, USA  
Telephone 703-312-6600  
Facsimile 703-312-6666

Attachments:  
Petition for Extension of Time  
Form PTO-2038 (Fee Code 1252)